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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,662	01/19/2006	Satoshi Omura	8012-1317	5881

466 7590 08/01/2007  
YOUNG & THOMPSON  
745 SOUTH 23RD STREET  
2ND FLOOR  
ARLINGTON, VA 22202

EXAMINER
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AUDET, MAURY A

ART UNIT	PAPER NUMBER
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1654

MAIL DATE	DELIVERY MODE
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08/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/532,662	OMURA ET AL.
	Examiner	Art Unit
	Maury Audet	1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 October 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,7-10 and 13-19 is/are pending in the application.  
 4a) Of the above claim(s) 2 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,7-10 and 13-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

***DETAILED ACTION***

The present application has been transferred from former Examiner Young to the present Examiner.

The amendment and response of 4/4/07 are acknowledged. Claims 1-2, 7-10, and 13-15 and new claims 16-19 are pending. Claim 2 is withdrawn from consideration. Claims 1, 7-10 and 13-19 are examined on the merits.

***Restriction made final***

As previously stated by the former Examiner, Applicant's election with traverse of Group I, claims 1, 7-10 and 13-15 in the reply filed on October 23, 2006 is acknowledged. The traversal is on the ground(s) that the inventions of Groups I-IV have a unique technical feature which is not shown by the other groups. This is not found persuasive because *the unique technical feature shared by the groups, the depsipeptide of the formula of claim 1 is not a contribution over the art because it is anticipated by Kalbe et al. (2001, WO 01/62268 A1; and 2002, WO 02/00202A1), in the depsipeptide disclosed in formula Ia, page 13 and formula Ia, page 14, respectively, thus showing the peptides claimed as not being a contribution over the art.*

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The rejection of claims 1, 7-10 and 13-15 and new claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kalbe et al. I, 2001, WO 01/62268 A1 (PCT/EP01/01392) and the same claims under 35 U.S.C. 102(a) as being anticipated by Kalbe et al. II, 2002, WO

02/00202 A1 (PCT/EP01/06836), is maintained for the reasons of record. Applicant's arguments (as well as 1.132 Affidavit) have been considered, but are not found persuasive. The elected invention remains drawn to products. The product is known, as expounded upon by the former Examiner, based upon Kalbe et al. I and II. Applicant's arguments, in the ten page response (as well as the 1.132 Affidavit) are directed to unexpected results related to the method of using this genus and species thereto. Applicant may wish to consider filing a continuation application directed to methods of use, and bring forth said arguments therein. (as opposed to methods of making/isolating-to which Applicant's arguments are substantively directed, as least in part).

The rejections are repeated below for continuity of record:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7-10 and 13-15 and new claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kalbe et al, 2001, WO 01/62268 A1 (PCT/EP01/01392). Kalbe et al. teach a depsipeptide anti-endoparasite agent as shown in Formula Ia, page 13, lines 15 et sequitur. The 24-member ring core structure and substituents recited in the listings of R-groups anticipate the depsipeptide of formula FKI-1033 as claimed in the instant application. Specifically, Kalbe et

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al's Formula Ia recites a C1 alkyl (methyl) group at position R1a, a C1 alkyl (methyl) group at position R2a, a C5 alkyl (pentyl) group at position R3a, a C1 alkyl (methyl) group at position R4a, a C5 alkyl (pentyl) group at position R5a, a C1 alkyl (methyl) group at position R6a, a C5 alkyl (pentyl) group at position R7a (mislabeled as R75a in the diagram on page 13), a C1 alkyl (methyl) group at position R8a, a C5 alkyl (pentyl) group at position R9a, a C1 alkyl (methyl) group at position R10a, a C1 alkyl (methyl) group at position R11a, and a C1 alkyl (methyl) group at position R12a. Kalbe et al's depsipeptide of Formula Ia is claimed in the instant claims 1, 9, 10, 13, 14 and 15. The other limitations recited in the instant claims are to characteristics inherent in the molecule, directly derived from and attributable to its structure. The characteristics are: Ryanodine-binding ability (instant dependent claim 7 and independent claims 9, 13 and 14) and the insecticidal and antihelminthic functions (instant dependent claim 8 independent claims 10, 13 and 15).

Claims 1, 7-10 and 13-15 and new claims 16-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Kalbe et al, 2002, WO 02/00202 A1 (PCT/EP01/06836). Kalbe et al. teach a depsipeptide anti-endoparasite agent as shown in Formula Ia, page 14, lines 1 et sequitur. The 24-member ring core structure and substituents recited in the listings of R-groups anticipate the depsipeptide of formula FKI-1033 as claimed in the instant application. Specifically, Kalbe et al's Formula Ia recites a C1 alkyl (methyl) group at position R1a, a C1 alkyl (methyl) group at position R2a, a C5 alkyl (pentyl) group at position R3a, a C1 alkyl (methyl) group at position R4a, a C5 alkyl (pentyl) group at position R5a, a C1 alkyl (methyl) group at position R6a, a C5 alkyl (pentyl) group at position R7a, a C1 alkyl (methyl) group at position R8a, a C5 alkyl (pentyl) group at position R9a, a C1 alkyl (methyl) group at position R10a, a C1 alkyl (methyl)

group at position R11a, and a C1 alkyl (methyl) group at position R12a. Kalbe et al's depsipeptide of Formula Ia is claimed in the instant claims 1, 9, 10, 13, 14 and 15. The other limitations recited in the instant claims are to characteristics inherent in the molecule, directly derived from and attributable to its structure. These inherent characteristics are: Ryanodine-binding ability (instant dependent claim 7 and independent claims 9, 13 and 14) and the insecticidal and antihelminthic functions (instant dependent claim 8 independent claims 10, 13 and 15).

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 7/21/2007

  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600